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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,939	05/01/2002	Jens Petter Hoili	3651-1001	8759

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,939	Applicant(s) HOILI, JENS PETTER	
	Examiner Clement B Graham	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 7, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-8, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al (Hereinafter Heinonen U.S Patent 6, 078, 806) in view of Elbaum U.S Patent 6, 010, 067.

As per claims 1-3, 6, and 20, Heinonen discloses a method for performing a payment transaction between a customer, a sales location and a payment operator, where the customer is equipped with a mobile communication unit, where the sales location is equipped with a payment terminal and where the payment operator is equipped with an operator system which is connected to a network which can communicate with the customer's mobile communication unit, which method comprises the following steps: a communication connection is established between the mobile communication unit and the payment terminal ("i. e, payment terminal, see column 5 line 45") the payment terminal transfers data comprising information concerning the transaction via the communication connection to the mobile communication unit (see column 12 lines 25-40 and column 8 lines 15-25) characterized in that the mobile communication unit transfers data comprising information concerning the transaction via the network to the operator system ("i. e, wireless interface") the operator system registers data comprising information concerning the transaction for subsequent charging, invoicing or other settlement (Note abstract and Fig.6 and see column 12 lines 25-65 and column 13 line 25-60) and wherein the data which are transferred via the communication connection from the payment terminal to the mobile communication unit and the data which are transferred via the network from the mobile communication unit to the operator system comprise data identifying the sales location ("i. e, cash register see col 12 line 45") and

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data representing the amount which has to be paid (see column 12 lines 25-55 and column 13 line 25-55) and wherein the data having been broadcast through a local radio broadcasting system at the sales location. (see column 4 lines 40-45 and column 10 line 65 and column 11 line 5 and column 12 line 55).

Heinonen fails to teach and wherein the data identifying the sales location are received in advance by the payment terminal.

However Elbaum discloses a central processing device interconnecting all of the devices wireless communication device, in use, being connectable with a wireless communications network to connect to a host EFTPOS network connected with a bank or credit establishment, said CPU being programmed to store merchant identifying data of the merchant owner/lessee of the device and to activate said PINpad device so a user, who is a distinct entity from said merchant owner/lessee, can enter user oriented information via said PINpad device, said information including a PIN number and at least one of, account type, account transaction type, and transaction amount, said PIN number being encrypted by said PINpad device, and wherein said PIN number is encrypted and said user entered information encrypted as a Message Authentication Code and stored by said CPU, activate a communication connection via said modem device and said interface device to connect with the host EFTPOS device and transmit the stored user entered data as well as transmit the merchant identifying data of the merchant owner/lessee of the device, so that funds can be transferred from the user's bank account or credit or debit card to the merchant owner/lessee's bank account or vice versa and to provide signals to the output report device confirming the transaction or other information relating to the transaction, wherein the mobile funds transaction device is mobile and portable and therefore can be moved from one location to another in view of the wireless communication device to thereby enable the funds transaction device to be used without need to be hard wired into a transmission system, and wherein said communication connection is activated by a telephone dialing routine controlled by the central processing unit, and said communication device is a mobile telephone device for permitting said communication.(see column 6 lines 40-65 and column 7 lines5-15).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Heinonen to include data identifying the sales location are received in advance by the payment terminal as taught by Elbaum in order to create a system for performing a payment transaction between a Mobile unit and payment terminal.

As per claims 4-5, Heinonen disclose a method according to claim 1, characterized in that the communication connection between the mobile communication unit and the payment terminal is established by an electrical connection through a communication port in the mobile communication unit or is established by an optical connection, preferably infrared transfer. (column 2 lines 50-55 and column 5 lines 10-20).

As per claim 7, Heinonen discloses a system for performing a payment transaction between a customer, a sales location and a payment operator, comprising a mobile communication unit for the customer, a payment terminal for the sales location and an operator system. (see column 5 line 45) connected to a network which can communicate with the mobile communication unit, characterized by a communication connection between the mobile communication unit and the payment terminal. (see column 5 line 45) and (Note abstract and Fig.6 and see column 12 lines 25-65 and column 13 lines 25-60) and electrical or optical communication port in the communication unit which is adapted to a corresponding communication port in the payment terminal and receiver equipment in the payment terminal. (column 2 lines 50-55 and column 5 lines 10-20) and arranged for receiving an identification for the sales location ("i. e, cash register see col 12 line 45") broadcast from a radio transmitter provided locally at or near the sales location, allowing information comprising said identification to be transferred to the mobile communication unit via the communication connection. (see column 4 lines 40-45 and column 10 line 65 and column 11 line 5 and column 12 line 55) and wherein the data which are transferred via the communication connection from the payment terminal to the mobile communication unit and the data which are transferred via the network from the mobile communication unit to the operator system comprise data identifying the sales location and data representing the

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amount which has to be paid (see column 12 lines 25-55 and column 13 line 25-55) and and wherein the data having been broadcast through a local radio broadcasting system at the sales location. (see column 4 lines 40-45 and column 10 line 65 and column 11 line 5 and column 12 line 55).

Heinonen fails to teach wherein the data identifying the sales location are received in advance by the payment terminal.

However Elbaum discloses a central processing device interconnecting all of the devices wireless communication device, in use, being connectable with a wireless communications network to connect to a host EFTPOS network connected with a bank or credit establishment, said CPU being programmed to store merchant identifying data of the merchant owner/lessee of the device and to activate said PINpad device so a user, who is a distinct entity from said merchant owner/lessee, can enter user oriented information via said PINpad device, said information including a PIN number and at least one of, account type, account transaction type, and transaction amount, said PIN number being encrypted by said PINpad device, and wherein said PIN number is encrypted and said user entered information encrypted as a Message Authentication Code and stored by said CPU, activate a communication connection via said modem device and said interface device to connect with the host EFTPOS device and transmit the stored user entered data as well as transmit the merchant identifying data of the merchant owner/lessee of the device, so that funds can be transferred from the user's bank account or credit or debit card to the merchant owner/lessee's bank account or vice versa and to provide signals to the output report device confirming the transaction or other information relating to the transaction, wherein the mobile funds transaction device is mobile and portable and therefore can be moved from one location to another in view of the wireless communication device to thereby enable the funds transaction device to be used without need to be hard wired into a transmission system, and wherein said communication connection is activated by a telephone dialing routine controlled by the central processing unit, and said communication device is a mobile telephone device for permitting said communication.(see column 6 lines 40-65 and column 7 lines5-15).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Heinonen to include data identifying the sales location are received in advance by the payment terminal as taught by Elbaum in order to create a system for performing a payment transaction between a Mobile unit and payment terminal.

As per claim 8, Heinonen discloses a system according to claim 7, characterized in that the mobile communication unit is a mobile telephone.(see Fig.6) and that the network comprises a mobile telephone network.(see column 8 lines 35-40 and column 13 line 25 and 55-60).

3. Claims 9-10 12-13 and 15-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Heinonen U.S Patent 6,078, 806.

As per claim 9, 16-19, Heinonen disclose a mobile payment transaction method, using a mobile communication unit communicating over a mobile communication network, and a payment terminal, comprising the steps: of using a customer's mobile communication unit to establish a communication connection with a payment terminal at a sales location .(see column 5 line 45 and column 8 lines 15-25) establishing the communication connection between the mobile communication unit and the payment terminal by placing the mobile communication unit in a physical proximity with a data connection of the payment terminal.(see column 5 line 45 and column 12 lines 25-65) and in establishing the communication connection between the mobile communication device and the payment terminal(see column 5 line 45) making an initial data transfer from the mobile communication unit comprising information concerning identification of the customer and the sales location (see column 5 line 45) and after the initial data transfer, transferring, from the payment terminal to the mobile communication unit, information concerning a transaction via the established communication connection the transferred information concerning the transaction including a transaction amount (see column 12 lines 25-55 and column 13 line 25-55) and transferring from the mobile communications unit to a payment operator system information comprising the information concerning the transaction(see column 12 lines 25-65) and the transfer to the payment operator system being placed through a network comprising a mobile

communication network used by the mobile communication unit the payment operator system being remote from the payment terminal.(see column 5 line 45 and column 12 lines 25-65) and wherein, the information concerning the sales location is initially transferred from the mobile communication unit to the payment terminal, and subsequently the transaction information is transferred from the payment terminal to the mobile communication unit, and thereafter from the mobile communication unit to the payment operator system via the mobile communication network.(see column 13 line 25 and 55-60)

As per claim 10 Heinonen The method of claim 9, wherein the data connection is achieved by connecting the mobile communication unit's built-in communication port with a port of the payment terminal. (column 2 lines 50-55 and column 5 lines 10-20).

As per claim 12 Heinonen discloses the method of claim 9, wherein the data connection is an infrared link.(see column 10 line 50).

As per claim 13 Heinonen discloses the method of claim 9, wherein the data connection is a radio link.(see column 10 line 50).

As per claim 15 Heinonen discloses the method of claim 9, wherein the data payment terminal is a mobile terminal that can be moved from one sales location to another sales location and is used operable at either the one sales location and the other sales location without any reprogramming.(See column 11 lines 55-60).

4. Claims 11 and 14, are rejected under 35 U.S.C 103(a) as being unpatentable over Heinonen US Patent 6,078, 806 as applied to claim 9 above, and further in view of Elbaum US Patent 6,010, 067.

As per claims 11-14 Heinonen and Elbaum fails to teach the data connection is a Bluetooth specification link or optical link.

However Bluetooth specification link and optical link are old and well known in the art because Bluetooth link and optical link just represents a different types or forms of data communication and would not have affected the data being transferred.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Heinonen could be modify to include Elbaum in order to perform data connection or communicating data.

Conclusion

Response to Arguments

5. Applicant's arguments filed on 04/07/2004 have been fully considered but are not persuasive for the following reasons.
6. In response to Applicant's arguments as it pertains to Heinonen and Elbaum.
7. In response to Applicant's arguments that prior art of reference fail to teach the recited claim feature of the invention these limitations are addressed in a combination of teachings as stated Heinonen discloses a communication connection is established between the mobile communication unit and the payment terminal see column 5 lines 43-48 the payment terminal transfers data comprising information concerning the transaction via the communication connection to the mobile communication unit see column 12 lines 25-40 and column 8 lines 15-25 characterized in that the mobile communication unit transfers data comprising information concerning the transaction via the network to the operator system ("i. e, wireless interface") the operator system registers data comprising information concerning the transaction for subsequent charging, invoicing or other settlement Note abstract and Fig.6 and see column 12 lines 25-65 and column 13 line 25-60 and wherein the data which are transferred via the communication connection from the payment terminal to the mobile communication unit and the data which are transferred via the network from the mobile communication unit to the operator system comprise data identifying the sales location see column 12 line 45") and data representing the amount which has to be paid see column 12 lines 25-55 and column 13 line 25-55 and wherein the data having been broadcast through a local radio broadcasting system at the sales location see column 4 lines 40-45 and column 10 line 65 and column 11 line 5 and column 12 line 55 and mobile communication unit for the customer, a payment terminal for the sales location and an operator system see column 5 line 43-47 connected to a network which can communicate with the mobile communication unit, characterized by a communication connection between the mobile communication unit and the payment terminal. (see column 5 line 43-47 and Note abstract and Fig.6 and see column 12 lines 25-65 and column 13 lines 25-60 and electrical or optical communication port in the communication unit which is adapted to a

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corresponding communication port in the payment terminal and receiver equipment in the payment terminal column 2 lines 50-55 and column 5 lines 10-20 and arranged for receiving an identification for the sales location ("i. e, cash register see column 12 line 45 broadcast from a radio transmitter provided locally at or near the sales location, allowing information comprising said identification to be transferred to the mobile communication unit via the communication connection see column 4 lines 40-45 and column 10 line 65 and column 11 line 5 and column 12 line 55 and wherein the data which are transferred via the communication connection from the payment terminal to the mobile communication unit and the data which are transferred via the network from the mobile communication unit to the operator system comprise data identifying the sales location and data representing the amount which has to be paid see column 12 lines 25-55 and column 13 line 25-55 and wherein the data having been broadcast through a local radio broadcasting system at the sales location see column 4 lines 40-45 and column 10 line 65 and column 11 line 5 and column 12 line 55 and a mobile payment transaction method, using a mobile communication unit communicating over a mobile communication network, and a payment terminal, comprising the steps: of using a customer's mobile communication unit to establish a communication connection with a payment terminal at a sales location see column 5 lines 43-48 and column 8 lines 15-25 establishing the communication connection between the mobile communication unit and the payment terminal by placing the mobile communication unit in a physical proximity with a data connection of the payment terminal see column 5 line 45 and column 12 lines 25-65 and in establishing the communication connection between the mobile communication device and the payment terminal see column 5 line 45 making an initial data transfer from the mobile communication unit comprising information concerning identification of the customer and the sales location see column 5 lines 43-48 and after the initial data transfer, transferring, from the payment terminal to the mobile communication unit, information concerning a transaction via the established communication connection the transferred information concerning the transaction including a transaction amount see column 12 lines 25-55 and column 13 line 25-55 and transferring from the mobile communications unit to a payment operator system

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information comprising the information concerning the transaction see column 5 lines 43-48 and column 12 lines 25-65) and the transfer to the payment operator system being placed through a network comprising a mobile communication network used by the mobile communication unit the payment operator system being remote from the payment terminal see column 5 lines 43-48 and column 12 lines 25-65 and wherein, the information concerning the sales location is initially transferred from the mobile communication unit to the payment terminal, and subsequently the transaction information is transferred from the payment terminal to the mobile communication unit, and thereafter from the mobile communication unit to the payment operator system via the mobile communication network see column 13 line 25 and 55-60 and a characterized in that the communication connection between the mobile communication unit and the payment terminal is established by an electrical connection through a communication port in the mobile communication unit or is established by an optical connection, preferably infrared transfer see column 2 lines 50-55 and column 5 lines 10-20.

Elbaum discloses a central processing device interconnecting all of the devices wireless communication device, in use, being connectable with a wireless communications network to connect to a host EFTPOS network connected with a bank or credit establishment, said CPU being programmed to store merchant identifying data of the merchant owner/lessee of the device and to activate said PINpad device so a user, who is a distinct entity from said merchant owner/lessee, can enter user oriented information via said PINpad device, said information including a PIN number and at least one of, account type, account transaction type, and transaction amount, said PIN number being encrypted by said PINpad device, and wherein said PIN number is encrypted and said user entered information encrypted as a Message Authentication Code and stored by said CPU, activate a communication connection via said modem device and said interface device to connect with the host EFTPOS device and transmit the stored user entered data as well as transmit the merchant identifying data of the merchant owner/lessee of the device, so that funds can be transferred from the user's bank account or credit or debit card to the merchant owner/lessee's bank account or vice

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versa and to provide signals to the output report device confirming the transaction or other information relating to the transaction, wherein the mobile funds transaction device is mobile and portable and therefore can be moved from one location to another in view of the wireless communication device to thereby enable the funds transaction device to be used without need to be hard wired into a transmission system, and wherein said communication connection is activated by a telephone dialing routine controlled by the central processing unit, and said communication device is a mobile telephone device for permitting said communication .see column 6 lines 40-65 and column 7 lines 5-15).

It is clear that the teachings of the claimed invention is taught by Heinonen and Elbaum.

8. In response to applicant arguments against the references individually, one cannot show nonobviousness by attacking the reference individually where the rejections are based on a combination of references. See *In re Keller*, 642 F.2d, 208 USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F.2d 1091, 231 USPTQ 375 (Fed. Cir. 1986).

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

December 21, 2004.

FToul
FRANZYS PONSIL
PRIMARY EXAMINER
Art 3628